

## REMARKS

### Overview

The current Office Action dated December 13, 2007 rejected the pending claims as follows: claims 16, 21, 24, 28, 85-86 and 88-93 under 35 U.S.C. § 102(e) as allegedly being anticipated by Hazzard et al. (U.S. Patent Application No. 2005/0125389).

Applicants hereby traverse the rejections of the claims, as discussed below. Thus, claims 16, 21, 24, 28, and 85-93 are pending, and claims 17-20, 22-23, 25-27 and 29-84 are currently withdrawn.

Applicants also thank Examiner Shah for her consideration during the telephone interview with Applicants' representative on April 10, 2008 on this application. During the interview, Applicants' representative and Examiner Shah discussed whether the finality of the current Office Action is proper, for the reasons discussed in the previous Response after final that was filed February 13, 2008. As previously noted, in the subsequent interview with Examiner Smith on April 15 and 18, 2008, Examiner Smith agreed that this current Response after final and the accompanying Rule 131 Declaration would be considered on its merits as a seasonable presentation.

### Analysis

As discussed below, in an effort to advance prosecution, Applicants have concurrently filed a revised Declaration Of Prior Invention under 37 CFR 1.131 by James White (referred to herein as "the current Declaration"), which demonstrates that Applicants diligently pursued the invention from a time prior to the December 9, 2003 effective date of the Hazzard reference until the filing of the present patent application on January 27, 2004. Accordingly, Applicants request that this revised current Declaration be considered on the merits as seasonably presented, as discussed in the Interview Summary issued by Examiner Smith on April 30, 2008.

Previously, as part of the prior Amendment filed on November 5, 2007, Applicants filed a Declaration Of Prior Invention under 37 CFR 1.131 (referred to herein as "the prior Declaration"). The Examiner has agreed that Applicants have demonstrated conception of the invention prior to the December 9, 2003 filing date of the Hazzard patent application (Office

Action dated August 3, 2007, page 6), and that Applicants have demonstrated diligence in pursuing the invention from December 17, 2003 through January 27, 2004 (Office Action dated December 13, 2007, page 7).

Thus, the remaining issue with respect to establishing that Applicants invented the present invention prior to the effective date of the Hazzard reference is whether Applicants have demonstrated that they diligently pursued the invention from a time just prior to December 9, 2003 and through the subsequent 8-day time period at issue until December 17, 2003.

The current Office Action indicated the following regarding the prior Declaration:

In this case, the applicant must account for the period just prior to December 9, 2003 (i.e. December 8, 2003), until January 27, 2007 [sic, 2004], when constructive reduction to practice occurred. . . . the applicant has accounted by affirmative acts diligence from December 17, 2003, to January 27, 2004. However, the applicant has not provided a specific date prior to December 9, 2003, the beginning of the period from which diligence is required. It is impossible to establish whether the diligence requirement is met because there is no date from which to determine whether the applicant was diligent. . . . the Declaration is ineffective to overcome the Hazzard reference.

Office Action dated December 13, 2007, pages 7-8, emphasis added.

As discussed in greater detail in the previous Response after final that was filed February 13, 2008, however, Applicants' prior Declaration did establish one or more specific dates prior to December 9, 2003 in which diligence-related activities occurred, despite the statement indicated above to the contrary. In particular, numbered paragraph 5 on page 2 of the prior Declaration indicated that "before the December 9, 2003 filing date of Hazzard, I began preparation of the above-referenced patent application, and spent at least 16 hours on activities related to preparation of the application, including on November 11, 2003". Applicants also discussed this November 11, 2003 date in the prior Amendment filed November 5, 2007 that accompanied the prior Declaration. Thus, Applicants previously demonstrated that activities related to the preparation of the present patent application occurred on November 11, 2003, which is prior to the December 9, 2003 filing date of Hazzard. Since the finding in the current Office Action of an alleged lack of a showing of diligence between December 9, 2003 and December 17, 2003 was based on the incorrect assertion that the prior Declaration did not provide a specific date prior to December 9, 2003, and since the prior Declaration did in fact demonstrate diligence-

related activities on a particular date prior to December 9, 2003, Applicants believe that the finality of the current Office Action is improper.

Furthermore, as noted above, Applicants have concurrently filed the revised current Declaration in an effort to advance prosecution, and the current Declaration further demonstrates Applicants' diligence in pursuing the current invention during the time period at issue (from a time just prior to December 9, 2003 and through the subsequent 8 days until December 17, 2003), as well as continuing on through January 27, 2004.

Applicants note that the MPEP states the following regarding diligence.

The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. . . . See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

MPEP Section 2138.06, emphasis added.

The revised current Declaration demonstrates that Applicants' patent attorney diligently prepared the present patent application in accordance with the MPEP and caselaw, with the entire time period at issue accounted for by either affirmative acts or acceptable excuses based in part on performing intervening work on a reasonable backlog of unrelated cases taken up in chronological order in an expeditious manner. In particular, numbered paragraph 5 on page 2 of the revised current Declaration indicates the following:

5. Beginning prior to the December 9, 2003 filing date of Hazzard, and continuing until the constructive reduction to practice on January 27, 2004 from the filing of the above-referenced patent application, I diligently participated in the preparation of the above-referenced patent application on a regular basis. In particular, before the December 9, 2003 filing date of Hazzard, I began activities related to preparation of the above-referenced patent application, including spending over 7 hours on November 11, 2003 on such activities. The activities that I performed on November 11, 2003 for the above-referenced application included activities after the invention disclosure meeting to identify and summarize information about patentable aspects to be pursued, and this matter was then placed in a chronological queue of work to be performed. On December 17, 2003, I initiated continuing activities for the above-referenced application that included beginning preparation of the claims, drawings and specification of the above-referenced application, with the application preparation work continuing as indicated in the table below until the filing of the above-referenced application on January 27, 2004. During the period of time between November 11, 2003 and December 17, 2003, I

generally worked in an expeditious manner on a backlog of other unrelated matters that chronologically arose before the above-referenced application. In particular, based on a review of available records of work performed during that period, as well as an existing policy at that time to perform work in a chronological manner absent exigent circumstances, I believe that the beginning of the preparation of the claims, drawings and specification of the above-referenced application on December 17, 2003 was performed in chronological order with respect to the other matters that were worked on between November 11, 2003 and December 17, 2003, and in particular with respect to the other matters that were worked on during the period of time from just prior to December 9, 2003 until December 17, 2003, with the possible exception of less than 8 hours total spent on matters whose time-sensitivity necessitated a direct response and whose date of chronological initiation is unclear from the available records. . . .

Day	Hours Worked	Activity
November 11, 2003	more than 7	After the disclosure meeting, identify and summarize information about patentable aspects to be pursued, and place matter in chronological queue of work to be performed
<i>November 12, 2003 – December 16, 2003</i>	<i>Average at least 8 per business day</i>	<i>Perform work on other matters that chronologically arose before the above- referenced application, as discussed above</i>
December 17, 2003	more than 7	Begin preparation of the claims, drawings and specification of the application
...		

Furthermore, the entire 8-day time period that is currently at issue (of which 6 days are non-weekend business days) is sufficiently short to typically be considered an excusable period of time without any relevant activity or explicit excuse. For example, the CCPA explicitly found that a 10 day period for review of the application by the inventors was sufficient diligence, as well as other periods without activity in that case, stating that “[a]s to the other alleged lapses of activity urged by appellant, these are all of such short duration that we consider them to fall within the limits of reasonable diligence, referred to in the cases cited by the board, which recognize the inevitable minor interruptions accompanying the conduct of patent prosecution.” *Application of Fancher*, Patent Appeal No. 8152, 410 F.2d 813 (CCPA 1969). More generally, periods of time such as 4 months and 6 months during which attorneys prepared patent application have been found to satisfy diligence, including when the attorneys were also working on other projects and spent significant periods of time between diligence-related activities. For example, in *Gould v. General Photonics Corp.*, 534 F.Supp. 339 (N.D. California 1982), the court concluded that “[f]rom December 2, 1958

to April 6, 1959 [a period of over 4 months], Mr. Keegan diligently applied himself to the preparation and filing of Gordon Gould's original applications (filed on April 6, 1959)," although the court did not list particular dates on which diligence-related activity occurred. In a 1994 decision by the Board of Patent Appeals and Interferences (*English v. Ausnit*, Interference No. 102,361, 38 USPQ2d 1625, 1994), however, the Board did recite attorney actions (listed below) that occurred over a 6-month period in which the attorney prepared and filed a patent application, and the Board concluded that "this evidence establishes attorney diligence for the period beginning 20 June 1986 and ending with Ausnit's 22 December 1986 filing date."

June 20, 1986 – inventor sent letter requesting that attorney prepare patent application

June 25 – attorney received request to prepare patent application; read and studied attached sketches

June 26 – case was docketed and assigned to other attorneys; sketches given to drafting

Sept. 3 – drafting finished

Nov. 11 – attorney finished draft of application

Nov. 12 – typing of draft application completed

Nov. 20 – application papers mailed to inventor

<date unclear> - inventor requested modifications to draft application

Dec. 3 – revised application sent to inventor

Dec. 9 – inventor mailed signed application papers to attorney

Dec. 15 – attorney receives the signed application papers

Dec. 22 – attorney files application with the Patent Office

Thus, in that case, two periods of over 2 months each (from June 26 to September 3, and from September 3 to November 11) occurred without any indication of particular diligence-related activity, as well as numerous other shorter periods of time (e.g., 8 days between completing the preparation of the draft application and sending it to the inventor for review, 7 days between receiving executed application papers and filing the patent application, etc.), and diligence was nonetheless established.

Accordingly, Applicants submit that the much shorter periods of inactivity that occurred in this case during the relevant time period of issue from December 8, 2003 to January 27, 2004

(at most 6 business days), coupled with the activities throughout the relevant period in preparing the application, clearly demonstrate diligence during the relevant period.

Furthermore, even if Hazzard were valid prior art, the pending claims are nonetheless patentable over Hazzard, as discussed in greater detail in the Amendment filed November 5, 2007. In particular, each of the pending claims as rejected includes features and provides functionality not disclosed by Hazzard, and thus is allowable over that reference.

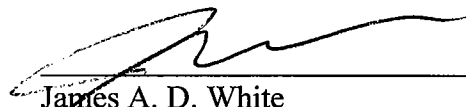
Accordingly, for all of the reasons discussed above, the rejection of the pending claims based on Hazzard is traversed, and the pending claims are thus allowable over the cited prior art. Applicants thus request that the finality of the current Office Action be withdrawn, and that all pending claims be timely allowed.

#### Conclusion

In light of the above remarks, Applicants respectfully submit that all of the pending claims are allowable, as are the withdrawn claims that depend from the independent method claim 16. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 694-4815.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,  
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